

REMARKS

After entry of this amendment, claims 7-27 remain pending. In the present Office Action, claims 1-6 were rejected under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) over Peters. Applicant has cancelled claims 1-6, and thus respectfully submit that these rejections are moot. Claims 14-27 were restricted. Applicant respectfully traverses the restriction requirement. Applicant has indicated the status of claims 14-27 as withdrawn in light of the restriction, but requests that the restriction requirement be withdrawn in light of the remarks below. Claims 7-13 are allowed.

Applicant respectfully requests that the restriction requirement be withdrawn because it would not be a serious burden on the Examiner to examine claims 14-27. Pursuant to MPEP 803, restriction is not proper if there is not a serious burden on the Examiner. In a telephone interview on July 15, 2005, the Examiner pointed out that a *prima facie* case of serious burden is established if the claims can be separately classified. Applicant respectfully submits that the *prima facie* case is rebutted below.

The Office Action states that the reasons for allowance of claim 7 are that the following limitations, in conjunction with the other claimed limitations, are not found in or suggested by the prior art:

a circuit board configured to be placed over a top of the component, the circuit board including a bottom side that faces the component during use, the bottom side of the circuit board comprising a first plurality of conductive pads to be electrically coupled to the power and ground pads on the component to supply power and ground connection to the component

Accordingly, the Examiner must have searched for prior art that taught or suggested those features, in order to consider a possible rejection of claim 7. No such rejection has been made, and claim 7 is allowed. Claim 14 recites, among other things:

a second circuit board configured to be placed over a top of the component... the second circuit board including a bottom side that faces the component during use, the bottom side of the second circuit board

comprising a first plurality of conductive pads to be electrically coupled to a corresponding second plurality of conductive pads on the component, the second plurality of conductive pads supplying power and ground connection to the component

Since these features of claim 14 are very similar to the features of claim 7, and since these features must have been searched in examining claim 7, Applicant respectfully submits that it is not a serious burden for the Examiner to examine claim 14 and presumably allow it for similar reasons leading to those leading to the allowance of claim 7.

Furthermore, Applicant respectfully requests that the restriction requirement be withdrawn because it is either improper or it is inconsistent with the Examiner's reasons for allowance of claim 7. The restriction requirement is made based on a combination/subcombination relationship. According to MPEP 806.05(a), a combination is an organization of which a subcombination or element is a part. Since claim 7 recites a component and a circuit board and claim 14 recites a circuit board, claim 7 is the combination and claim 14 is the subcombination. (Applicant notes that the Examiner appears to cite claim 7 as a subcombination of claim 14 in the restriction requirement. However, claim 7 recites elements not recited in claim 14 and thus is not a subcombination of claim 14 since a subcombination must be a part of a combination). Given the reasons for allowance stated above, the Examiner appears to be of the opinion that features of the circuit board recited in claim 7 are essential to the combination recited in claim 7. Restricting claim 14 as a subcombination of claim 7 is inconsistent with the Examiner's reasons for allowance, pursuant to MPEP 806.05(c)(II), which states that restriction is not proper if features of the subcombination are essential to the combination.

For at least the above stated reasons, Applicant submits that the restriction requirement should be withdrawn. Applicant respectfully requests withdrawal of the restriction requirement.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5500-99300/LJM.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Request for Approval of Drawing Changes
- ☐ Notice of Change of Address
- ☐ Fee Authorization Form authorizing a deposit account debit in the amount of \$
for fees ().
- ☐ Other:

Respectfully submitted,



Lawrence J. Merkel

Reg. No. 41,191

AGENT FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8800

Date: 7/15/05